

IN THE UNITED STATES PATENT AND TRADEMARK OFFICIAL
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
SHIODA

Serial No. 09/444,120

Filed: November 19, 1999

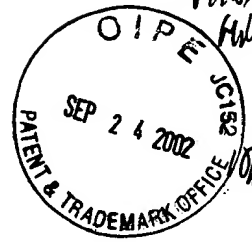
For: GOLF PRACTICE AND EXERCISE DEVICE

Docket: 019441.023

Confirmation No.: 8235

Group Art Unit: 3711

Examiner: Gordon, R.



Charlotte, North Carolina

Commissioner for Patents
Washington, D.C. 20231

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APPEAL BRIEF

Sir:

I. Real Party in Interest

The real party in interest with regard to the present application is Yoshihiko Shioda.

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TYPED NAME: Donna B. Millard
SIGNATURE: *Donna B. Millard*

II. Related Appeals and Interferences

Appellant is not aware of any related appeals or interference proceedings.

III. Status of Claims

Claims 1, 3,4, 6-24, 27, and 28 are pending in the present application, with claims 1 and 18-23 having been finally rejected in the Office Action mailed May 20, 2002 (Paper No. 13). Specifically, claims 1, 18, 21 and 23 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by McLaughlin, U.S. Patent No. 1,847,570 ("McLaughlin"), and Clements, U.S. Design Patent No. D366,679 ("Clements"); claims 19 and 20 stand finally rejected under 35 U.S.C. 103(a) as unpatentable over Clements; and claim 22 stands finally rejected under 35 U.S.C. 103(a) as unpatentable over Clements or McLaughlin in view of Miles, U.S. Patent No. 708,573 ("Miles"). Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Appellant has submitted an amendment concurrent herewith to place claims 7-10 in allowable form. Claims 3, 4, 6, 11-17, 24, 27 and 28 have been withdrawn from consideration as not directed to the elected species. Claims 2, 5, 25 and 26 have been canceled. Appellant is appealing the final rejection of claims 1, and 18-23.

There are no other claims pending, canceled or withdrawn that are associated with this application.

Appealed claims 1 and 18-23 are reproduced in Appendix A attached hereto.

IV. Status of Amendments

All amendments have been entered. An amendment filed concurrently with this Brief rewrites claim 7 as an independent claim to overcome the objections raised by the Examiner

concerning claims 7-10. Appellant believes that the concurrently filed amendment follows suggestions by the Examiner and places claims 7-10 in condition for allowance.

V. Summary of the Invention

The golf practice and exercise device of the present invention provides a golfer with a strike-able object to promote muscle development without the golfer needing to concentrate on hitting a small object, i.e. a golf ball, and also improve golf swing technique without having to continually retrieve the struck object. (Specification p. 2, lines 2-18). The golf practice and exercise device comprises a frame having a flat base portion and an upright portion extending upwardly from the base portion. (Id at p. 5, lines 7-9). A mounting arm projects outwardly from the frame portion over a portion of the base portion. (Id. at lines 9-11). At the outward end of the mounting arm, an object is suspended so that the object can be struck by a golf clubhead swung by a golfer. (Id. at lines 11-14). At least a portion of the object is adjacent the floor or ground. (Id. at lines 12-14 and claim 1). The size of the golf clubhead impact surface of the object is at least that of a conventional softball. (Id. at p. 7 lines 15-17) The size of the golf clubhead impact surface allows the golfer to swing a golf club without having to concentrate on striking a small target such as a golf ball. (Id. at p. 6 lines 18-20). The mass of the object is at least that of a conventional softball. (Id. at p. 7 lines 15-19) The mass of the object provides for muscle development for increased performance when hitting a golf ball while allowing the clubhead to move under the object for completion of the follow-through of the swing. (Id. at pp. 6-7, lines 20-9).

The object is suspended from the mounting arm by a flexible cord. (Id. at p. 5, line 12 and claim 18). The flexible cord is attached to a ring that is freely rotatably mounted at the outward end of the mounting arm so that, when struck, the object, cord and ring rotate about a

generally horizontal axis. (Id. at lines 20-22, and claim 21). The mounting arm is adjustable to a height of between about 1.5 feet and about 5 feet above the base, preferably about 3 feet. (Id. at p. 7 lines 12-14 and claims 19 and 20). The object may be selectively attached to the base portion of the frame to restrain the object against movement for alternative use of the object as a stop of the golf club in an impact position, thus allowing the golfer to practice a golf swing technique. (Id. at page 8, lines 1-6 and claim 22 and 23).

VI. Issues

There are three issues on appeal: firstly, whether claims 1, 18, 21 and 23 are unpatentable under 35 U.S.C. 102(b) as being anticipated by McLaughlin and Clements (individually); secondly, whether claims 19 and 20 are unpatentable under 35 U.S.C. 103(a) over Clements; and finally, whether claim 22 is unpatentable under 35 U.S.C. 103(a) over Clements or McLaughlin in view of Miles.

VII. Grouping of Claims

With respect to the issues on appeal, claims 1, and 18-23 stand or fall together.

VIII. Argument

THE REJECTION OF CLAIMS 1, 18, 21 AND 23 UNDER 35 U.S.C. 102(B) AS BEING ANTICIPATED BY CLEMENTS AND MCLAUGHLIN SHOULD BE REVERSED BECAUSE NEITHER CLEMENTS NOR MCLAUGHLIN DISCLOSES EACH AND EVERY ELEMENT DISCLOSED IN THE CLAIMS IN QUESTION.

In the Office Action of November 30, 2001 (Paper No. 9, page 2, paragraph 4), the Examiner rejected claim 1, 18, 21, and 23 under 35 U.S.C. 102(b) for being anticipated by Clements and McLaughlin, individually. The Office Action stated that Clements and McLaughlin disclose "tethered ball hitting aids comprising a base, a frame extending upward, an

arm extending parallel to the ground, and a flexible cord" to which is attached a tethered ball. The Office Action also stated without qualification that the tethered ball is a "golf ball." The Office Action continued by noting that the United States Golf Association (USGA) Golf Ball Specifications require a golf ball to have a minimum diameter of at least 1.68 inches, but have no limit regarding the maximum diameter. Interpreting the silence of the USGA specifications about the maximum diameter of a golf ball, the Examiner concluded that a "golf ball" could be any size (equal to or greater than the minimum) including that of a softball and, hence, the term "golf ball" of Clements and McLaughlin anticipated the "softball" element disclosed in the present invention.

Appellant responded by providing various references, incorporated herein by reference, discussing the traditional and current size of a golf ball, as known and used by golfers and sanctioned by the leading golf championship authorities (Amendment filed February 8, 2002, pages 3-6, reprinted in Appendix B attached hereto). Appellant supplemented his response by adding that the golf hole, in which a golf ball must fit, is specified to be 4.5 inches in diameter. (Supplemental Response filed February 20, 2002). Further, the Appellant noted that the golf ball must fit within the golf hole when a golf flagstick is in place in the golf hole. (Id.) Therefore, Appellant concluded, a golf ball could not be greater than about 2 inches in diameter, much smaller than a conventional softball and, hence, the balls disclosed in Clements and McLaughlin do not read on the object of the present invention. (Id.)

The Examiner found Appellant's argument unpersuasive and maintained the position that a "golf ball" may be a ball of any size greater than or equal to 1.68 inches in diameter. (Office Action mailed May 20, 2002, Paper No. 13, p. 3, paragraph 7). Accordingly, the Examiner maintained the rejection. (Id. at p. 2, paragraph 2).

Appellant contends the rejection issued by the Examiner in the Office Action of November 30, 2001, and maintained in the Office Action of May 20, 2002, is not supported by the cited prior art and should be reversed. Specifically, Appellant contends that Clements and McLaughlin, individually, do not disclose each and every feature of the claimed invention.

As discussed above, the invention disclosed by Appellant in claim 1 includes the following elements: a base, a frame extending upwardly from the base; a mounting arm projecting from the upper most extent of the frame; an object swingably suspended from the mounting arm; at least a portion of the object adjacent the ground or floor; the object having a clubhead impact surface of a size at least that of a softball; and the object having a mass at least that of a softball. Claim 18, depending from claim 1, adds to the limitations of claim 1 the use of a flexible cord to suspend the object from the mounting arm. Claim 21, depending from claim 18, further adds the limitation that the flexible cord is attached to a ring that is freely mounted on the mounting arm to allow the object, cord and ring to rotate about a horizontal axis when the object is struck. Claim 23, an independent claim, is discussed in a separate part of this section.

Clements, a design patent disclosing the ornamental design of a tethered ball hitting practice aid, shows a base, a frame extending upwardly therefrom, an arm projecting from the frame over a portion of the base and a tethered spherical object. Appellant contends that Clements does not disclose the type of spherical object used, the size or mass of the object, whether the object is positioned adjacent the ground, whether the object is swingably suspended from the mounting arm, or whether the invention is useable with a golf club. Thus, Appellants contend that Clements does not read on each and every limitation of the claimed invention and, accordingly, does not anticipate the claimed invention.

McLaughlin discloses a golf practice set comprising a base plate, a vertical standard extending upwardly therefrom, a sliding adjustable horizontal arm attachable to the standard, a golf ball attached to a cord suspended from a hook attached to a wire rod suspended from the horizontal arm, and a ring guide to restrain the motion of the golf ball such that when struck, the golf ball rotates about a vertical axis. Appellant contends that McLaughlin fails to disclose the use of an object having the size and mass at least that of a softball. Appellant further contends that the Examiner's position that a "golf ball" reads on an object having the size of a softball because the USGA only specifies a minimum size for a golf ball but is silent regarding the maximum size relies on an incorrect interpretation of the size limitation required by the USGA.

As discussed in Appellant's Response filed February 8, 2002, the smaller the diameter of the ball, the farther it can be hit. Therefore, it is to a golfer's advantage to use the smallest possible golf ball, and to the golfer's disadvantage to use a ball greater in diameter than his competitors. Thus, the impetus for restricting the smallest diameter a golf ball may be is to prevent a golfer from taking unfair advantage of the size-to-distance correlation. While the rules are silent regarding the maximum diameter a golf ball may have, one skilled in the game of golf recognizes the disadvantage of using a golf ball that does not substantially conform to the minimum allowed size. Indeed, this recognition is so prevalent that one would be hard pressed to find a golf ball having a diameter significantly greater than the 1.680 inch minimum listed in the rules.

Even if common sense does not lead one to the conclusion that a golf ball cannot approach the size of a softball, then the practicalities of the game of golf should. As noted in Appellant's Supplemental Response filed on February 20, 2002, the golf ball must be of a size small enough to fit within the golf hole, even when the flagstick is in place in the hole. The golf

hole is 4.5 inches in diameter and the flagstick, which is typically placed in the center of the golf hole, is about 0.5 inches in diameter. This leaves an open area no greater than about 2 inches in which a golf ball must fit. Thus, Appellant contends that although the rules of golf are silent regarding the maximum diameter allowed for a golf ball, other elements of the game dictates that a golf ball must be no greater than 2 inches in diameter. A softball is generally between 4 and 5 inches in diameter, substantially bigger than even the 2 inches allowed by the golf hole. Thus, Appellant contends that the Examiner's position that the "golf ball" disclosed in McLaughlin reads on the object disclosed in the present invention is incorrect and unsupported. Accordingly, Appellants contend that McLaughlin cannot anticipate the present invention.

Additionally, the Examiner's position is unsupported when the terms "golf ball" and "softball" are afforded their plain meaning, as understood by a reader skilled in the art of sports practice aids. "[W]ords in a patent claim are construed as they would be understood by a reader skilled in the relevant art unless it appears that the inventor used the words differently." Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531, 41 USPQ2d 1001 (Fed. Cir. 1997). Nothing in McLaughlin indicates that the inventor used the term "golf ball" to mean anything different than what is conventionally understood to be a golf ball. Thus, the plain meaning of the term "golf ball" in McLaughlin is a ball that meets the requirements for playing the game of golf as governed by the recognized rules of the game having a diameter no smaller than 1.680 inches and a weight not greater than 1.620 ounces avoirdupois. See The Rules of Golf 2000-01, Appendix III, Paragraphs 1 and 2 (USGA 1999), attached as a reference to Appellant's Response filed February 8, 2002. Likewise, nothing in the current application indicates that the term "softball" should be used differently than that understood by those skilled in the sports art. Indeed, the Appellant, in the specification, clearly distinguishes between using a suspended

object at least the size of a softball and a golf ball, stating that when using the present invention, "the golfer can swing freely without concentration on striking a small target, such as a golf ball," (Specification, page 2, lines 9-10), and that because of the size of the suspended object, "the golfer need not be concerned or concentrate on the specific location of the clubhead at the striking surface as he is when practicing with a golf ball." (Id. at p. 6, lines 18-20). Thus, using the plain meaning of the terms "golf ball" and "softball", Appellant contends that one of ordinary skill in the relevant art would not consider the "golf ball" of McLaughlin to be of a size sufficient to overlap the "softball" disclosed in the current application. Accordingly, Appellant contends that McLaughlin, again, cannot anticipate the claimed invention.

Regarding the rejection of claim 18, Appellant contends that, in addition to the deficiencies noted concerning claim 1, neither Clements nor McLaughlin teaches use of a flexible cord to suspend a strike-able object from a mounting arm. Indeed, Clements cannot teach the use of a cord or any other material for suspending the spherical shaped object shown in the drawings thereof. Although McLaughlin does teach the use of a flexible cord, the cord is attached to a hook on a wire rod suspended from the mounting arm (col. 1, lines 17-21). In contrast, the present invention uses a flexible cord attached at one end to the mounting arm and to a strike-able object at an opposite end. (Figs. 1-5, Specification p. 5, lines 11-12).

Regarding the rejection of claim 21, Appellant contends that, in addition to the deficiencies noted concerning claims 1 and 18, neither Clements nor McLaughlin teaches attaching the cord to a ring that is freely rotatably mounted on the arm for rotation of the ring, cord and object about a generally horizontal axis. Clements only shows a spherical shaped object attached to a length of undisclosed material that is attached in some undisclosed manner to a horizontal arm. Clements does not, indeed cannot, disclose how the length of material is

attached to the arm and, specifically, whether the object, material and attachment rotate about a horizontal axis. McLaughlin, in direct contrast to the present invention, teaches restraining the tethered golf ball by a "horizontally disposed ring" which prevents the ball from "diverting from a circular plane and [preventing] any liability of the cord twisting round the horizontal arm." (cols. 1-2 lines 49-52, col. 2, lines 66-71). Thus, not only does McLaughlin not teach the limitation disclosed in claim 21, but McLaughlin actually teaches away from the invention as disclosed in claim 21.

Claim 23 of the current application includes the following elements: a base; a frame extending upwardly therefrom and having an outwardly extending mounting arm; and an object secured to and extending between the mounting arm and the base - the object is secured to both the mounting arm and the base and positioned therebetween - in position for striking by a golf club during a normal golf swing and stopping the club at the impact position upon striking the secured object. Appellant contends that neither Clements nor McLaughlin teaches securing a strike-able object to both the mounting arm and the base to prevent the object from moving when hit. Thus, Clements and McLaughlin do not anticipate the present invention as disclosed in claim 23 of the current application.

For the above reasons, Appellant contends that Clements and McLaughlin do not read on each and every element of the present invention disclosed in claims 1, 18, 21 and 23. Accordingly, Appellant contends that the rejection of claims 1, 18, 21 and 23 as being anticipated by Clements and McLaughlin is incorrect. Therefore, Appellant respectfully requests reversal of the rejection.

THE REJECTION OF CLAIMS 19 AND 20 UNDER 35 U.S.C. 103(A) AS UNPATENTABLE OVER CLEMENTS SHOULD BE REVERSED BECAUSE CLEMENTS DOES NOT TEACH OR SUGGEST THE PRESENT INVENTION.

In the Office Action of November 30, 2001 (Paper No. 9), claims 19 and 20 were rejected as being rendered obvious by Clements (p. 3, paragraph 6). Specifically, the Examiner stated that Clements disclosed the present invention except for the height of the arm being adjustable, but that it was obvious to adjust the height of the arm. (Id.) Appellant responded by observing that claims 19 and 20 depended, indirectly, from independent claim 1, that Clements did not render claim 1 obvious, and, hence, Clements could not render claims dependent therefrom obvious. (Appellant's Amendment filed February 8, 2002, p. 6). The Examiner maintained the rejection of claims 19 and 20 as being obvious over Clements. (Office Action mailed May 20, 2002, Paper No. 13, p. 2, paragraph 4). Appellants contend that Clements does not render the present invention obvious because Clements fails to satisfy the criteria for establishing obviousness. Specifically, Appellant contends that Clements does not provide the necessary motivation or suggestion to be modified to create the present invention, nor does Clements teach each and every element of the present invention.

To establish obviousness, the following criteria must be met: there must be some motivation, either in the reference or in knowledge generally available to one of ordinary skill in the art, to modify the reference in such a way as to create the claimed invention; the reference must provide a reasonable expectation of successfully being modified; and the reference must teach each and every element of the claimed invention. See In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Appellant contends that Clements does not satisfy the listed criterion and, thus, does not establish obviousness.

To satisfy the first criterion, there must be some motivation or suggestion, either from the cited reference or in the knowledge generally available to one of ordinary skill in the relevant art, to be modified to create the present invention. See In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). One test used for this determination is whether one of ordinary skill in the art, having the cited reference in his possession, would find the cited reference sufficient to make the proposed modification. See In re Linter, 173 U.S.P.Q. 560 (CCPA 1972). Appellant contends that Clements does not meet this threshold because Clements does not suggest that the design disclosed therein may be adjusted in any way. Furthermore, Appellant disputes the notion that knowledge generally available to one of ordinary skill in the art would motivate such a person, in possession of Clements, to modify Clements to make the height of the arm adjustable. Thus, Appellant contends that the first criterion for finding obviousness is not satisfied.

To satisfy the third criterion for finding obviousness, Clements must teach each and every element of the claimed invention. As discussed in the previous section, Appellant contends that Clements does not meet this requirement. Specifically, Clements does not teach having a portion of the strike-able object adjacent to the ground or floor; the object having an impact surface of a size equal to or greater than that of a softball; the object having a mass equal to or greater than a softball; and the object being suspended from the mounting arm by a flexible cord. In addition to the previously listed deficiencies, Clements does not disclose any height for the mounting arm, and specifically does not teach the height of the arm being approximately 1.5 to 5 feet, preferably 3 feet, from the ground. Thus, Appellant contends that Clements does not teach each and every element of the present invention and, thus, fails to satisfy the third criterion for establishing obviousness.

Appellant contends that Clements does not satisfy the criterion for establishing obviousness and, thus, Clements cannot render the present invention obvious. Accordingly, Appellant respectfully requests reversal of the rejection.

THE REJECTION OF CLAIM 22 UNDER 35 U.S.C. 103(A) AS UNPATENTABLE OVER CLEMENTS OR MCLAUGHLIN IN VIEW OF MILES SHOULD BE REVERSED BECAUSE THE COMBINATIONS DO NOT TEACH OR SUGGEST THE PRESENT INVENTION.

In the Office Action of November 30, 2001, claim 22 was rejected under 35 U.S.C. 103(a) as being rendered obvious over Clements or McLaughlin in view of Miles. (Paper No. 9, p. 3, paragraph 7). Specifically, the Examiner stated that Clements and McLaughlin disclosed the present invention except for connecting the strike-able object to the base, but that Miles teaches a ball connected at opposite ends by flexible cord. (Id.) The Examiner concluded that one skilled in the art "would have attached the ball with an additional cord in order to restrain the ball from movement." (Id.) Appellant responded by directing the Examiner's attention to the specification of Miles in which it is disclosed that the ball in Miles "is free to move and to turn in all directions." (Appellant's Amendment filed February 8, 2002, p. 7 quoting from Miles, col. 2, lines 61-62). In the Office Action of May 20, 2002, the Examiner disregarded the teachings of Miles and maintained the rejection.

Appellant contends that the combinations of Clements and Miles and of McLaughlin and Miles do not render the present invention obvious because they fail to teach or suggest the present invention and they fail to teach every element of the present invention.

The teachings of Clements and McLaughlin are discussed in detail above. Briefly, Clements and McLaughlin disclose practice aids comprising a ball tethered by a single cord (or

other material) to a mounting arm. Miles discloses a captive-ball apparatus comprising a pocket in which a ball is placed, two elastic suspension cords secured to opposite ends of the pocket and rows of hooks to secure the cords opposite the pocket. (col. 2 line 82 to col. 3, line 33 and col. 4, lines 65-70). The apparatus allows the ball to move in all directions (col. 2, lines 61-62) to simulate, as much as possible, the actual conditions experienced during a game (col. 2, lines 53-56). One such experience provided by the invention is the rebound of a ball after being hit or kicked. (col. 4, lines 61-63).

The present invention, as disclosed in claim 22, teaches a device comprising a base, a frame extending upwardly therefrom and having a mounting arm attached thereto, and an object suspended from the mounting arm and attachable to the base for restraining the object from movement for use as a stop of a golf club at an impact position arrived at during a normal swing by a golfer. The object has an impact surface equal to or greater in size than a softball; and the mass of the object is equal to or greater than the mass of a softball.

As discussed in the previous section, the following criteria must be met to establish obviousness: there must be some motivation, either in the references or in knowledge generally available to one of ordinary skill in the art, to combine the references or modify the references in such a way as to create the claimed invention; the references must provide a reasonable expectation of successfully combining or being modified; and the references must teach each and every element of the claimed invention. See In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Appellant contends the cited combinations of Clements or McLaughlin in view of Miles do not satisfy the criterion and, thus, does not establish obviousness.

Appellant contends that the combinations of Clements and Miles and of McLaughlin and Miles do not satisfy the first criterion because neither combination suggests creating a practice

device that restrains a strike-able object from movement in any direction so that the object is used as a stop of a golf club in an impact position arrived at during a normal swing of a golf club. Clements, McLaughlin and Miles all disclose tethered balls that are displaced from their original position upon being struck by another object. Clements and McLaughlin disclose tethering strike-able objects with one cord or other material. Mile discloses tethering a pocket (in which is placed a ball) by attaching elastic suspension cords (col. 3, lines 2-7, col. 4, lines 65-68) to opposite sides of the pocket. Appellant contends that one of ordinary skill in the art, when combining the teachings of Clements and Miles or McLaughlin and Miles would understand that the combinations result in a tethered ball that moves when hit. None of the cited references suggest tethering a ball in such a manner as to restrain movement of the object so that the object may be used to stop a golf club when said club intersects the impact surface of the object, as taught by the current application. Indeed, Appellant contends that such restraint of the ball would render Clements, McLaughlin and Miles inoperable for their stated purpose, i.e., having a strike-able object that moves when hit. Thus, Appellant contends that the references cited in the Office Action fail to suggest or motivate one of ordinary skill in the art to combine said references to create the present invention. Accordingly, Appellant contends that the combinations relied upon as bases for rendering the present invention obvious instead fail to satisfy the first criterion for establishing obviousness.

Similarly, Appellant contends the cited combinations fail to satisfy the second criterion for establishing obviousness because said combinations teach away from the present invention as disclosed in claim 22. The second criterion - the references must provide a reasonable expectation of successfully combining or being modified - is not met if the references teach away from the invention, or renders the references inoperable for their purpose. As discussed above,

the references teach tethering a ball, or pocket containing a ball, in a manner that allows the ball to move in any direction. Conversely, the present invention restrains the object from movement so that the object is a stop of a golf club. Therefore, the references - Clements, McLaughlin and Miles - teach away from the present invention. Thus, the references fail to satisfy the second criterion for finding obviousness.

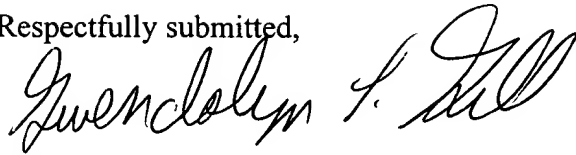
Finally, Appellant contends that the references fail to teach each element of the present invention and, hence, fail to satisfy the third criterion for establishing obviousness. Specifically, the references fail to teach use of a strike-able object having an impact surface at least as large as a softball, the object having a mass at least that of a softball, and securing the object to a mounting arm and a base to restrain movement thereof for use of the object as a stop of a golf club when the club is swung and impacts that object.

Appellant contends that, for the reasons set forth above, the combinations of Clements and Miles and of McLaughlin and Miles do not satisfy the requirements for establishing obviousness. Thus, the present invention as disclosed in claim 22 is patentable over said combinations. Accordingly, Appellant respectfully requests the reversal of the rejection.

IX. Conclusion

Therefore, for all of the aforementioned reasons, it is respectfully submitted that the final rejections should be reversed and that the pending claims be found allowable. Enclosed herewith is the fee of \$160 due for the filing of this Appeal Brief. The Commissioner is also authorized to charge any other fee which is due or to credit any fee overpayment which has been made to Deposit Account No. 18-1215.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gwendolyn L. Gill". The signature is fluid and cursive, with the first name being the most prominent.

Gwendolyn L. Gill

U.S. Reg. No. 46,214

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APPENDIX A

1. (Twice Amended) A golf practice and exercise device for use with a golf club, comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club, said object having a golf clubhead impact surface of a size at least that of the corresponding surface of a softball to provide a large target so that the golfer can swing a golf club freely without concentration on striking the small target of a golf ball, said object being of a mass at least that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of a golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow-through of the golf swing.

18. A golf practice and exercise device according to claim 1 in which said object is suspended from said mounting arm by a flexible cord.

19. A golf practice and exercise device according to claim 18 in which said arm is approximately 1½ to 5 feet above the ground or floor.

20. A golf practice and exercise device according to claim 18 in which said arm is approximately 3 feet above the ground or floor.

21. A golf practice and exercise device according to claim 18 in which said cord is attached to a ring that is freely rotatably mounted on said arm for rotation of said ring, cord and object about a generally horizontal axis.

22. A golf practice and exercise device according to claim 1 in which said object is alternatively attachable to said base for restraining said object against movement for alternative use of said object as a stop of the golf club in an impact position.

23. A golf practice and exercise device comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object secured to and extending between said mounting arm and said base in position for striking by a golf clubhead during a normal golf swing and stopping the golf clubhead in an impact position.

Appendix B.**Reprint of Appellant's Discussion Regarding the USGA's
Specification of a Minimum Diameter for a Golf Ball
(from Amendment Filed February 8, 2002)**

The Official Action states that the USGA specification for a golf ball is that it may have a diameter of at least 1.68 inches or more. It is true that The Rules of Golf of the USGA defines the size of a golf ball as "The diameter of the golf ball shall not be less than 1.680 inches (42.67mm)." (Appendix III, paragraph 2, copy enclosed), but that by itself is not a teaching, disclosure or suggestion of any prior art golf ball being of any size other than 1.680 inches.

The object of golf is to use the least number of strokes in playing a round, which is facilitated by being able to hit the ball as far as possible, and the smaller the ball, other factors being equal, the farther the ball will go. The reason for the rule limiting how small a golf ball can be is to provide a standard so that no one is able to gain an advantage by using a ball of a smaller size that travels a greater distance. Obviously, the teaching is to have a golf ball as close to 1.680 inches in diameter as possible so that the greatest travel distance will be attainable. Certainly, it would be contrary to the teachings of golf ball prior art to increase the size appreciably to the order of the presently claimed size of a softball or greater. There is no prior art cited or known to applicant disclosing, teaching or suggesting a golf ball having a diameter greater than 1.72 inches, which is only 0.02 inches larger than the minimum allowed.

As stated in the below-identified publications, copies of which are enclosed, a standard minimum diameter for a golf ball was established to prevent smaller balls from being used as smaller balls, not larger balls, were an advantage. If all balls were the same size, no one would be able to have an advantage by using a smaller ball. At one time, the required golf ball diameter was 1.62 inches, which was later increased to a "big ball" size of the present 1.68 inches.

In Chapter Two Evolution & Innovation of The Illustrated Encyclopedia of Golf there is the following reference on page 25 to the “feathery” ball used in the 17th and early 18th Century:

It weighed about the same as the modern ball (that is, 1.62 ounces) and was usually a similar size, though in those days there was no uniform diameter.

On pages 26 and 27, it is stated:

In 1920 they [R&A and USGA] agreed the ball should weigh no more than 1.62 ounces and have a diameter of not less than 1.62 inches, a radical move since until then there had been no restrictions whatsoever, although the earlier enforcement of a 4-1/4-inch hole obviously ruled out ridiculously large spheres. Both bodies pledged to “take whatever steps they think necessary to limit the powers of the ball with regard to distance should any ball of greater power be introduced.”

But from January 1931, the USGA turned its back on collective responsibility and opted for independence. The “big ball” was introduced, having a minimum size of 1.68 inches and a maximum weight of 1.55 ounces. A year later the weight stipulation was raised to 1.62 ounces and that remains the position.

and on page 28 it is stated:

In January 1993, Spalding announced the launch of its Magna ball. It has a diameter of 1.72 inches. (Remember the current regulations only stipulate a *minimum* diameter of 1.68 inches.) In addition to the manufacturers’ claim that the ball supplies the average golfer with distance, accuracy and feel, its greater size also means less spin - which should mean that it slices and hooks less than a conventional ball!

And in the Chapter entitled The PGA European Tour of The Illustrated Encyclopedia of Golf, page 132 it is stated:

In 1968 the British PGA, heeding those who considered the 1.68-inch ball to be a factor behind America’s supremacy in professional golf, announced that the big ball would be compulsory in all its tournaments for a three-year experimental period. This controversial decision heralded the beginning of the end of the 1.62-inch ball for professionals (though it was permitted in the Open until 1974) and initiated the process by which all club golfers in Britain today play with the big ball.

In Golf in America, Chapter Two The USGA Champions the Game, page 33, it is stated:

Since the beginning, golf balls had come in differing sizes and weights. In the gutta-percha days, Harry Vardon played with a ball 1.7 inches in diameter, and some early wound balls had been 1.71 inches and 1.72 ounces. Anybody could do anything with a ball; no rules applied. Before an R&A medal tournament played during a raging October gale in the nineteenth century, Maitland Dougal, one of the club's better golfers, drilled a hole in his gutta-percha ball, stuffed it with buckshot to hold it low in the wind, slogged around in 112 and finished second.

Manufacturers had been producing balls that flew farther and farther, and courses were playing shorter and shorter. Attempting to control distance, the USGA and the Royal and Ancient acted together in 1921 and set uniform standards. The ball could weigh no more than 1.62 ounces and measure no less than 1.62 inches in diameter. The agreement lasted ten years, until the USGA broke once more with the R&A, lowered the approved weight to 1.55 ounces and increased the size to 1.68 inches. The new ball was a failure. It was so light the wind tossed it about in flight, and a putted ball quickly lost momentum and would not hold its line. The weight was increased to 1.62 ounces again in 1932, but the diameter remained at 1.68 inches. It has stayed constant ever since, and within the last fifteen years has become the standard size ball throughout the world. The Royal and Ancient announced in 1987 that the old 1.62-inch ball no longer could be played in its championships, and would be phased out completely in 1990.

In Chapter Eight From Hickory Cleeks to Metal Woods of Golf in America, page 186 and 187, it is stated:

The original wound-rubber balls were light and large, about 1.55 ounces and 1.71 inches in diameter. No regulations governed ball size and weight, so manufacturers tried various combinations looking for the longest, straightest flight. A heavier core was popular for a time, then both size and weight dropped, so in 1915, when Haskell's original patent expired, 1.62 ounces and 1.63 inches in diameter were roughly standard.

Once the patent ended, competitors mushroomed. Just as development of the gutta-percha ball threatened courses, so did the wide variety of rubber balls suddenly available. In 1920, the United States Golf Association (USGA) and the Royal and Ancient (R&A) Golf Club of St. Andrews, Scotland, the two recognized governing bodies of golf, jointly agreed on ball-size restrictions. As of May 1, 1921, balls used in their competitions could no longer weigh more than 1.62 ounces or measure less than 1.62 inches.

Over the next decade, the USGA experimented with different limits. In 1923, the association stated that a ball could weigh no more than 1.55 ounces while measuring no less than 1.68 inches. This "balloon ball" came into play in the United States in 1931, but proved too light to hold a line while in flight or on

the green; it was gone after one year. The new rules in 1932 read 1.62 ounces and 1.68 inches, standards that still apply today. The British held to the original 1.62/1.62 all along, but as America came to dominate the game, the smaller ball fell out of favor.

The reference in these articles to a ball of a diameter of 1.72 inches being a "Magna ball," and a ball of 1.71 inches being "large," and that the specified 1.68 inch ball is a "big ball" and a "balloon ball," is a disclosure, teaching and suggestion that the largest prior art golf ball was of a diameter of 1.72 inches, not the size of a softball, which falls in the range of 4 to 6 inches.